

### REMARKS

This paper is in response to the official action dated August 14, 2003 (hereafter, "the official action"). This paper is timely-filed as it is accompanied by a petition for an extension of time to file in the first month and a check covering the requisite small entity extension fee.

Prior to entry of the foregoing amendments, claims 1-20 were pending. By the foregoing amendments, claims 1, 4, 11-15, and 17-19 have been amended. After entry of the present amendments, claims 1-20 will remain at issue.

The specification has also been amended.

Support for the amendments may be found variously throughout the application and in the claims as originally filed. No new matter has been added.

In the official action, claims 1-7 have been rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 3,825,253 to Speyer (hereafter, "Speyer") in view of U.S. Patent No. 5,011,138 to Rankin (hereafter, "Rankin"), U.S. Patent No. 4,444,396 to Wendt (hereafter, "Wendt"), and in further view of the Choice1 Medical Distributors website advertisement "Hausmann Pulley Weights: Extra 2 lb Weight Plate" (hereafter, "Choice1"). Claims 8-11 have been rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 6,193,635 to Webber *et al.* (hereafter, "Webber") in view of Rankin, Wendt, and in further view of Choice1. Claims 12-14 have been rejected under 35 U.S.C. §103(a) as obvious over Speyer in view of Rankin, Wendt, and in further view of Webber. Claims 15-20 have been rejected under 35 U.S.C. §103(a) as obvious over Speyer in view of Rankin, Wendt, Choice1, and in further view of Webber.

The various bases for the objection to the specification and the claim rejections will be addressed in the order presented in the official action. Reconsideration of the application, as amended, is solicited in view of the following comments.

### OBJECTION TO THE SPECIFICATION

Throughout the application and claims, the word "Olympic" was erroneously used to describe an embodiment of an incremental weight in accordance with the invention, which can be used with a standard barbell (especially a modern standard barbell wherein the barbell end portions that receive the weights are about two times the diameter of the barbell gripping portion) and a set of standard free weights.

In response to the examiner's objection to the applicant's improper use of the trademark "Olympic," the specification and the claims have been amended to delete each recitation of the word.

In view of such amendments, the applicant respectfully submits that the objection to the specification has been overcome and should be withdrawn.

### CLAIM REJECTIONS – 35 U.S.C. §103(a)

A prima facie case of obviousness *requires* three basic criteria. *First*, there must be some suggestion or motivation, either in the references themselves, or in knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. *Second*, there must be a reasonable expectation of success in doing so. *Third*, prior art references, when combined, must teach or suggest all of the claim limitations. *See* M.P.E.P. §2142.

At least the first and third criteria have not been satisfied with respect to all pending claims 1-20, as explained in more detail below. In view of these deficiencies, the applicant respectfully submits that the obviousness rejections of claims 1-20 should be withdrawn.

#### Claims 1-7:

The applicant respectfully traverses the rejection of claims 1-7 as obvious over Speyer in view of Rankin, Wendt, and in further view of Choice1.

Speyer discloses a weight training apparatus comprising a barbell and a set of free weights including a centrally disposed bore and a slot. Speyer does not disclose the exact weights of the free weights; however, a standard weight increment of 10 pounds appears to be shown in Figure 8. Accordingly, Speyer does *not* disclose or suggest a plurality of incremental weights ranging in weight from about one-quarter

ounce to about thirty-two ounces, as recited by claims 1-7, to be used with a standard barbell and free weights or with a cable-type weight training apparatus. The examiner recognized this deficiency of Speyer. *See* official action at page 2.

In view of Speyer's failure to disclose or suggest a plurality of incremental weights ranging in weight from about one-quarter ounce to about thirty-two ounces for use with the indicated conventional weight training devices, the examiner turned to Rankin, Wendt, and Choice1. However, there is no motivation to combine Rankin, Wendt, and/or Choice1 with Speyer because Rankin, Wendt, and/or Choice1 are not concerned with *weight training devices and methods*, which use very light incremental weights with a conventional weight training apparatus such as a standard barbell and free weights or a cable-type weight training apparatus.<sup>1</sup> Additionally, *even* the extraordinary combination of these four references fails to disclose or suggest a plurality of incremental weights ranging in weight from about one-quarter ounce to about thirty-two ounces, wherein each incremental weight comprises a thin disk having a center opening and a slot (*i.e.*, the incremental weights of the invention have been structurally adapted for use with a conventional weight training apparatus), as recited by claims 1-7.

For example, despite the examiner's characterization of Rankin as disclosing an "exercise device that utilizes 1/8 of an ounce plates..." (*see* official action at page 3), Rankin does not relate to incremental weight training, but rather *merely* teaches elaborate *gaming devices* requiring a combination of "delicate dexterity" and "brute strength." The *gaming devices* present a challenge, for example, wherein a player grasps and tilts an unbalanced pole to "let a ball roll along a slippery track on a round trip from one end of the pole to the other and back without losing either the ball of the two lower of four rings carried on a support positioned at the inner end of the pole while dislodging the two upper rings...." *See* Rankin at column 1, lines 23-68. The *gaming devices* can be made more difficult by "loading of one or more weight discs 35 on the outer end of pole 10 [to] produce an instantaneous shifting of its balance point for the upcoming round..." *See* Rankin at column 7, lines 16-18. The disclosed

---

<sup>1</sup> This observation is relevant here because the very light incremental weights of claims 1-3 recite structural features (*i.e.*, a center opening and a slot) which facilitate their use in connection with conventional weight training devices and methods, and claims 4-7 recite a standard barbell and a set of standard free weights.

disks weigh 1/8 of an ounce. However, Rankin does not disclose using the disks in connection with conventional weight training devices and methods which use a conventional weight training apparatus. Moreover, the disks are not structurally adapted for use with a conventional weight training apparatus such as a standard barbell and free weights or a cable-type weight training apparatus.

Accordingly, Rankin does not disclose or suggest an incremental weight training system or apparatus at all, much less one that includes a plurality of incremental weights ranging in weight from about one-quarter ounce to about thirty-two ounces, which have been structurally adapted for use with a conventional weight training apparatus. Its combination with Speyer therefore adds nothing further to the obviousness analysis.

Additionally, the entirety of the disclosure of Rankin is directed to *gaming devices*. Therefore, Rankin constitutes *nonanalogous art* with respect to the conventional weight training apparatus of Speyer (*i.e.*, standard barbell plus free weights), and its combination with Speyer is improper. *See* M.P.E.P. §2141.01(a).

Wendt was cited for its disclosure of "an exercise device that utilizes weight plates of various sizes weighing 1, 2, 4, 8 and 16 ounces...." *See* official action at page 4. More specifically, however, Wendt discloses a set of circular disks comprising one-ounce, two-ounce, four-ounce, eight-ounce, and sixteen-ounce weights, which can be used in conjunction with a *golf club* to provide a weighted golf club for "gradually increasing the strength, stamina and suppleness of the muscles of a golfer so as to enable him to play golf to the best of his ability." *See* Wendt at column 1, lines 17-22.

Wendt does not disclose or suggest an incremental weight training system or apparatus including a plurality of incremental weights ranging in weight from about one-quarter ounce to about thirty-two ounces, which have been structurally adapted for use in conventional weight training methods. Its combination with Speyer therefore also adds nothing further to the obviousness analysis.

Additionally, Wendt is nonanalogous art because Wendt is exclusively directed to golf related activities. The rejection should be withdrawn because it is improper to rely on a reference which is not "in the field of the applicant's endeavor

or ... reasonably pertinent to the particular problem with which the invention was concerned.” *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992).

Finally, Choice1 *merely* discloses a two pound plate for use with a standard cable-type weight training apparatus. Therefore, Choice1 does not disclose or suggest a plurality of incremental weights ranging in weight from about one-quarter ounce to about thirty-two ounces or structurally adapting such weights for use with a conventional weight training apparatus, as recited by claims 1-7.

Moreover, Choice1 illustrates the nonobviousness of the incremental weights in accordance with the invention because Choice1 provides a relatively large increment (*i.e.*, a two pound plate) as the lowest weight increment for weight training methods using a cable-type weight training apparatus. Such increments are too large of an increase for adults, and such an increase in exercise resistance is proportionally larger for children. *See* present application at page 1, line 30 to page 2, line 2. Therefore, the applicant respectfully submits that further evidence of the non-obviousness of the claimed subject matter is that Choice1 actually teaches away from the claimed invention by teaching such a large increment.

The applicant further submits that an additional indicia of the nonobviousness of the claimed subject matter is present in the differences between the way the incremental weights in accordance with the invention are used with respect to the weights disclosed by Rankin and Wendt. In particular, Rankin and Wendt use weights at the distal end of a recreational device to change the properties of the device to be gripped for movement at the end of the device remote from the weights, whereas the incremental weights in accordance with the invention are used to incrementally increase the resistance of traditional weight training devices and methods in small weight increments, thereby allowing a weight lifter to make consistent weight lifting gains and achieve strength training goals with little or no possibility of failure.

Because none of the cited references discloses or suggests an incremental weight system or an incremental weight training apparatus comprising a plurality of incremental weights ranging in weight from about one quarter-ounce to about thirty two-ounces, which is structurally adapted for use with an incremental weight training apparatus, as recited by claims 1-7, the rejection should be withdrawn.

Claims 8-11:

The applicant respectfully traverses the rejection of claims 8-11 as obvious over Webber in view of Rankin, Wendt, and in further view of Choice 1 for the reasons set forth above with respect to claims 1-7.

Webber merely discloses a standard cable-type weight training apparatus and a set of plate/weights of standard increments such as 5 pounds, 10 pounds, etc. *See* Webber at column 6, lines 14-17. Webber also discloses add-on plates "in various incremental weights of 5 lbs or less." *See* Webber at column 6, lines 43-44. Webber, therefore, does not disclose or suggest an incremental weight system or an incremental weight training apparatus comprising a plurality of incremental weights ranging in weight from about one quarter-ounce to about thirty two-ounces, which is structurally adapted for use with an incremental weight training apparatus. Its combination with the previously discussed documents does not add anything further to the obviousness analysis of the pending claims.

Claims 12-14:

The applicant respectfully traverses the rejection of claims 12-14 as obvious over Speyer in view of Rankin, Wendt, and in further view of Webber for the reasons provided above with respect to claims 1-7 and 8-11.

Claims 15-20:

The applicant respectfully traverses the rejection of claims 15-20 as obvious over Speyer in view of Rankin, Wendt, Choice1, and in further view of Webber for the reasons provided above with respect to claims 1-7 and 8-11.

Moreover, the applicant asserts that the methods of incrementally increasing a person's strength by incremental weight training according to claims 15-20 have not been disclosed or suggested for the additional reason that the cited art fails to suggest or disclose weight training methods wherein the starting resistance is increased *in increments of less than about five-ounces* to provide an incrementally increased resistance, and a weight training exercise is executed at the incrementally increased resistance.

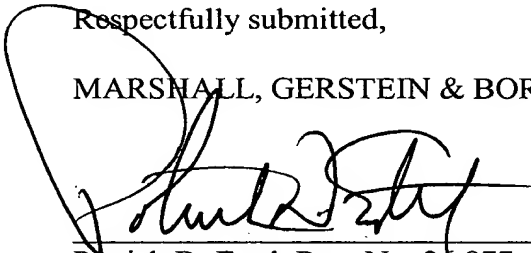
CONCLUSION

It is respectfully submitted that the application is now in condition for allowance. Should the examiner wish to discuss the foregoing amendments and/or comments, or any matter of form or procedure in an effort to advance this application to allowance, he is respectfully invited to contact the undersigned attorney at the indicated telephone number.

December 15, 2003

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP



Patrick D. Ertel, Reg. No. 26,877

Attorney for Applicant

6300 Sears Tower

233 S. Wacker Drive

Chicago, Illinois 60606-6357

(312) 474-6300